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WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606				MOONEYHAM, JANICE A
ART UNIT		PAPER NUMBER		
		3629		

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/757,206	HALLIGAN ET AL.
	Examiner	Art Unit
	Janice A. Mooneyham	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 May 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-70 and 119-123 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-70 and 119-123 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This is in response to the applicant's communication filed on May 1, 2006, wherein claims 1-70 and 119-123 are currently pending. Claim 120 has been amended. Applicant is requesting reconsideration of the April 4, 2006 Office Action.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-70 and 119-123 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant's specification does not disclose adequate structure for performing the recited function. For example, in claim 1 the applicant claims a ***means within the programmed computer for providing*** a predetermined criteria for evaluating a potential trade secret. In claims 8-12, 14, 16-20, 23-31, 49-51, 53-56, 60, 62-63, 67 and 69, applicant claims a means for characterizing (whether the trade secret constitutes negative know-how, whether the trade secret is a combinational trade secret), means for specifying security measures, means for associating said security measures with a trade secret, means for specifying, means for determining which security measures are needed, means for specifying security threats, means for analyzing the ratio, means for specifying values for the six factors of a trade secret, means for determining employee exposure to a trade secret, means for characterizing employee exposure, means for characterizing security risk.

MPEP Section 2163.06 states:

Lack of written description is an issue that generally arises with respect to the subject matter of a claim. If an applicant amends or attempts to amend the abstract, specification or drawings of an application, an issue of new matter will arise if the content of the amendment is not described in the application as filed. Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.

**If new matter is added to the claims**, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Applicant should therefore specifically point out the support for any amendments made to the disclosure.

The Examiner has reviewed the specification and submits that the added limitations find no support in the specification as currently written and is therefore, directed to new matter. The applicant specification appears to teach a questionnaire wherein a user inputs the values. The amended claim language wherein applicant claims a means within the programmed computer for providing a predetermined criteria for evaluation, a means within the programmed computer for receiving a numerical score value for the potential trade secret, a means within the programmed computer for calculating a metric, and a means with the programmed computer for ranking the potential trade secrets. Applicant's specification provides no teaching or disclosure for a means within the programmed computer to provide the predetermined criteria and receive a numerical score, or rank the potential trade secrets. As set forth in claim 1 as originally filed, the computer interface allows for the entry and display of data. The evaluation and characterization are all performed outside of the computer.

3. Claims 1-70 are 119-123 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically, the Examiner asserts that one skilled in the pertinent art could not make and use applicant's invention without undue experiments.

First, applicant recites various means for performing many of the recited steps. However, as set forth below, in many of the claims, the means for doing the step is a human being, outside the computer. For example, what is the means of indexing trade secrets, means for characterizing, means for specifying security measures, means for determining which security measures are needed, means for specifying security threats, etc.

MPEP 2164 sets forth:

#### The Enablement Requirement

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention.

#### 2164.01 Test of Enablement

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telecommunications, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies*, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

#### UNDUE EXPERIMENTATION

The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge CellCulture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), aff'd sub nom., *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

### 2164.01(a) Undue Experimentation Factors

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (reversing the PTO's determination that claims directed to methods for detection of hepatitis B surface antigens did not satisfy the enablement requirement). In *Wands*, the court noted that there was no disagreement as to the facts, but merely a disagreement as to the interpretation of the data and the conclusion to be made from the facts. *In re Wands*, 858 F.2d at 736-40, 8 USPQ2d at 1403-07. The Court held that the specification was enabling with respect to the claims at issue and found that "there was considerable direction and guidance" in the specification; there was "a high level of skill in the art at the time the application was filed;" and "all of the methods needed to practice the invention were well known." 858 F.2d at 740, 8 USPQ2d at 1406. After considering all the factors related to the enablement issue, the court concluded that "it would not require undue experimentation to obtain antibodies needed to practice the claimed invention." *Id.*, 8 USPQ2d at 1407.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27USPQ2d 1510, 1513 (Fed. Cir. 1993).

The applicant has applied for an invention identified as a programmed computer for identifying trade secrets. Claim 1 identifies the program computer to comprise a means within the programmed computer for providing predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of six factors. The invention claims a means for receiving a numerical score value for the potential trade secret under the predetermined criteria.

First, there is not sufficient direction as to how to produce this numerical score value for the potential trade secret. The specification does not set forth explicit ranges or explicit criteria for the scores to allow one of skill in the art to make or use the invention without undue experimentation. For example, on page 6 of the specification the applicant states that applicant may provide information about the estimated values of the six factors of a trade secret, such as a 1 to 5 scale. On page 20 of the specification, the applicant states that the other five factors for each trade secret may be characterized by a value, for example, a number on a scale of 1 to 5. Through out the specification, the applicant provides tables, for example, Table A, Example of Trade Secret Data, and page 15, Table B, Example Company Data. On page 20 of the specification, Table C, the applicant provides Example Definitions of Values for the Six Factors. Applicant states on page 8 of the specification that once data is entered, various analyses may be requested of the system to be performed on the data. The applicant further states that the accounting system may calculate various weightings of the six factors for each trade secret. The applicant states *[t]hese weightings we call defendability factors, or defensibility factors, and maybe calculated using logical and*

*mathematical formulae that may be configured into the accounting system and that the company may deem best meet its needs.* Through out the specification, the applicant states that calculation may be made using a logical and mathematical formula that may be configured into the accounting system and the company may deem best meets its needs (see page 18 of the specification). On page 24 of the specification, the applicant states that the assigned values may be averaged to provide the relevant metric.

Alternatively, the six assigned values may be multiplied and the sixth root taken of the product. The metric obtained using such process may be compared by the user or by the accounting system with a threshold value. Where the metric exceeds the predetermined threshold level, a determination may be made that a protectable trade secret exists. No predetermined threshold level is identified in the specification or no directions as how to produce this threshold level are set forth.

The Examiner asserts that there is a lack of concreteness in applicant's invention due to the inability of the invention to produce reproducible results. The applicant provides brief descriptions and multiple examples to try to place factors and calculations into context. However, there is not sufficient direction and guidance as to how to arrive at estimated values of the six factors, there is not sufficient direction and guidance to calculate the various weightings of the six factors, there is not sufficient direction and guidance as to how the potential trade secrets are ranked. There is not sufficient direction or guidance as to a precise scale for providing a numerical score, a precise formula for calculations preformed, ie, calculating various weightings of the six factors, calculating a value for security factors, calculating the net present value of each trade

secret, calculating ratios, a precise definition of the one or more threshold values. All of these limitations are elusive due to the inconcrete nature, thereby casting doubt on the ability of one of ordinary skill in the art to produce absolutely repeatable and predictable results when attempting to analyze these scenarios, for multiple companies.

The applicant's invention has a means within the programmed computer for calculating a metric from the received numerical score values. There is not sufficient direction or guidance as to how the calculation is performed. The applicant has provided no formulas with which the applicant performs the calculation. The applicant has not defined how the security measure factor is determined. The applicant talks about a threshold value in the specification and never really defines how the threshold value is determined. How are the values weighted? How is the net present value of a trade secret calculated? How is the economic benefit factor calculated? What and how are the characterizations as to whether the trade secret constitutes negative know-how made? In claim 22, the applicant claims a means for calculating various weighted values of the six factors using logical and mathematical equations. The applicant has failed to provide the mathematical equations used to perform calculations. How are the security threats factors calculated?

The Examiner's assertion that one skilled in the pertinent art could not make and use the applicant's invention is further emphasized by applicant's remarks in the request for re-consideration filed on May 11, 2006. Applicant states on page 33 ***that the evaluative judgments themselves are outside the scope of the claimed invention. The output of the invention is a ranked list that is an aggregation of the user-***

***provided evaluative judgments. The ranked list is an aggregation of the user's own judgments and certainly has utility for the user himself. The applicant further states that the claims of the application are directed to the broad concepts described in the specification and include all contexts which perform the specified claim steps regardless of the specific calculations used.***

On page 34, the applicant states that ***how one would use the numerical score and the definition of the numerical score are not germane. The applicant's claim all contexts which perform the specified claim steps regardless of how the numerical score is defines.***

The applicant has identified an invention which requires the user to input information into a computer through the use of a questionnaire with multiple-choice questions wherein many of the questions have answers that are provided by the subjective analysis of the user. Because the answers are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

4. Furthermore, claims 1-70 and 119-121 are also rejected under 35 U.S.C. 112, first paragraph since the claimed invention is not supported by either a specific asserted utility or a well established utility. For the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The applicant has not defined the numerical score. There is no defined meaning as to the score. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response).

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-70 and 119-123 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect

In the present case, many of the answers to the multiple-choice questions in the questionnaire are subjective. Thus, because the answers are subjective, for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

Furthermore, the claimed invention is not supported by either a credible asserted utility or a well established utility. It is unclear how the specific utility of the claimed invention as described in the disclosure of this application would be useful or tangible to one in the industry. It is unclear how the numerical score value would be used by a person in the industry, i.e., what does the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response). For example, an academic test score of 95 is

considered an A unless specifically defined otherwise. What does the numerical score value that is derived by this invention mean and to whom does it have a meaning. Is there a threshold value that has a real world meaning?

6. Claims 8-31, 49-56 and 69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2105 states if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.

The means for performing the function in the above referenced claims appears to be a human being. Therefore, these claims are directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 121 are rejected under 35 U.S.C. 102(e) as being anticipated by Donner (US 6, 263, 314).

Referring to Claims 1, 3-35, 37-39 43-44, 47-57, 60-63, 67-70, and 121:

Donner discloses a system for providing documentation, analysis, auditing, and accounting of IP (which includes trade secrets), said system comprising:

a data processing means for calculating (Fig. 1 (6), Fig. 8 (250); col. 11, lines 1-10);

a user interface means for providing predetermine criteria for a user to evaluate a potential trade secret and to receive a numerical score (Figure 1 (2); Fig. 7, Fig. 8 (264));

a mass data storage means (Fig. 1 (4)(5), Fig. 2);

a means for indexing (Fig. 3 (indicator collection organizing device));

a means for storing or archiving or indexing (Fig. 1 (4) (5), Fig. 2);

a means for associating (Fig. 1 (10), Fig. 3 comparison device);

a means for analyzing, comparing and weighing (col. 5, lines 5-17; Figure 1 (8)

Figure 2 (20));

a means for ranking (col. 9, lines 61-64)

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art system is fully capable of performing that function (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

8. Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 121 are rejected under 35 U.S.C. 102(e) as being anticipated by Elder (US 6,393, 406).

Elder discloses a system comprising:

data processing means (Fig. 3 (136);

user interface for providing predetermined criteria and receiving data (Fig. 1 (20));

mass data storage means (Fig. 1 (15, 10, 30, 35, 40, 50) Fig. 3 (135)

printer means (Fig. 3 (137), Fig. 12 (118))

calculating means (Fig. 1 (400), Fig. 12 (772))

comparison or analysis means (Fig. 12 (773))

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art is fully capable of performing the function. (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 42, 45-46, 58-59 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner and Elder as applied to claim 1 above, and further in view of Haber et al (US 5,136,646) (hereinafter referred to as Haber).

Neither Donner or Eder disclose an application fingerprint of the data. However, Haber discloses creating an application fingerprint of the data (col. 3, lines 50-55).

It would have been obvious to one of ordinary skill in the art to combine the fingerprint as taught by Haber with the scoring and ranking disclosed in Donner and Eder so that once the scored and ranked information is stored, there is a way to verify the date so that, should the time become a matter for later proof, the established procedure serve as effective evidence in substantiating the fact.

10. Claims 2 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner as applied to claim 1 above, and further in view of Eder.

Donner does not disclose a printer. However, Eder discloses a printer (Figure 7 (137)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the auditing system of Donner the printer of Eder so that the reports generated could be produced for in hardcopy for review and storage.

11. Claims 119-120 and 122-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer (US 6,356,909) (hereinafter referred to as Spencer) in view of Barney et al (6,556,992) (hereinafter referred to as Barney).

Spencer discloses computer method, system and program, comprising:  
providing a questionnaire of multiple-choice questions (Figures 14, col. 12, line 65 thru col. 13, line 18 - *multiple choice questions*) ;  
providing a numerical score value to each of the responses on the questionnaire (col. 12, line 65 thru col. 13, line 18 *multiple choice questions may have a sliding value depending on the answer selected. Each question/selection is given a weight that is used to develop a scorecard*);  
accepting responses to the questionnaire through the input device (col. 13, lines 11-18 *individual question responses*, Figure 3A – (4) *Response database*);  
converting the responses received to a numerical score value (col. 12, line 65 thru col. 13, line 18 *scorecard*).

Spencer does not disclose that the subject matter of the invention is trade secrets or that the questions relate to the six factors for a trade secret of the First Restatement of Torts, or calculating a geometric mean, the sixth root of the product, of the numerical score values to create a single metric, or repeating the program for each of the remaining items to be evaluated or ranking the items in ascending or descending order of the calculated metric.

However, Barney discloses repeating the program for each of the remaining items to be evaluated and ranking the items, wherein the items are patents and other

intangible intellectual property assets (*trade secrets*) (col. 5, lines 56-62, col. 6, lines 3-9 *ratings or rankings are generated using a database of information by identifying and comparing various characteristics of each patent to a statistically determined distribution of the same characteristic within a given patent population*, col. 7, lines 51-60 – *ranking in ascending or descending order is inherent in the definition of ranking as admitted by applicant on page 18 or the Remarks*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ranking of intellectual property assets as taught by Barney into the disclosure of Spencer so as to allow an entity to identify and study relevant characteristics of intellectual property to determine and measure those metrics that are predictive of a possible future event, such as an intangible intellectual property asset being litigated.

Although Barney discloses a rating for patents and other intangible intellectual property assets, neither Spencer or Barney explicitly disclose rating trade secrets or the questions relating to the six factors for a trade secret of the First Restatement of Torts or calculating a geometric mean, the sixth root of the product, of the numerical score value.

However, a geometric mean is old and well known. Geometric mean as defined by the Merriam Webster on line dictionary as:

Main Entry: **geometric mean**  
Function: *noun*  
: the nth root of the product of  $n$  numbers; *specifically* : a number that is the second term of three consecutive terms of a geometric progression <the *geometric mean* of 9 and 4 is 6>

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Spencer to include a geometric mean that is the sixth root of the product since the applicant has identified six factors for a trade secret, thus the 6<sup>th</sup> root of the product of 6 numbers to come up with a numerical score value which can be used for comparison purposes when making an analysis of the trade secret.

The fact that the subject matter is about trade secrets or that the questions relate to the First Restatement of Torts is determined to be non-functional descriptive data. The language is not functionally interrelated with the useful acts, structure or properties of the claimed invention. The weighted scoring and ranking would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F. 3d. 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide weighted scoring and ranking of trade secrets because such data does not functionally relate to the steps of the method or the structure of the system and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

***Response to Arguments***

12. Applicant's arguments filed May 11, 2006 have been fully considered but they are not persuasive. The applicant is requesting reconsideration of the Office Action mailed on April 6, 2006.

13. Claims 1-70 and 119-123 are rejected under 35 USC section 112, first paragraph.

The applicant argues the Examiner's rejection under 35 USC 112, first paragraph for failed to comply with the enable requirement.

However, the Examiner finds the applicant's statements to provide support for the Examiner's rejection. For example on page 33 of the response, the applicant states that the evaluative judgment is itself outside of the claimed invention. Thus, the Examiner asserts that this is an admission by applicant that the data being entered into the computer is subjective.

The applicant further states that the claims of the application are directed to the broad concepts described in the specification and include all contexts which perform the specified claim steps regardless of the specific calculations used. This statement in and of itself, would lead one to believe that one skilled in the art to which the invention pertains would not know how to use or make the invention without undue experimentation.

Applicant states that the result of the use of the invention for any given set of evaluative judgments is determinate and specific. The evaluative judgments are outside

the scope of the claimed invention. The output of the invention is a ranked list that is an aggregation of the user provided evaluative judgments and certainly has utility for the user himself. Examiner's requirement that the output of the invention have utility to someone other than the user is without statutory foundation.

On page 34, the applicant states that questions as to how one would use the numerical score and the definition of the numerical score are not germane. The applicants claim all contexts which perform the specified claim steps regardless of how the numerical score is defined. Applicant states that examples of possible definitions of the numerical score, the arithmetic mean and the geometric mean are provide in the specification.

The Examiner asserts that these statements further support the lack of enablement and the lack of utility.

MPEP 2164.01(c) states as follows:

#### How to Use the Claimed Invention

If a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637,643 (CCPA 1965). See also *In re Brana*, 51 F.2d 1560, 1566, 34 USPQ2d 1437, 1441 (Fed. Cir. 1993).

For example, it is not necessary to specify the dosage or method of use if it is known to one skilled in the art that such information could be obtained without undue experimentation. If one skilled in the art, based on knowledge of compounds having similar physiological or biological activity, would be able to discern an appropriate dosage or method of use without undue experimentation, this would be sufficient to satisfy 35 U.S.C. 112, first paragraph. The applicant need not demonstrate that the invention is completely safe. See also MPEP § 2107.01 and § 2107.03.

When a compound or composition claim is limited by a particular use, enablement of that claim should be evaluated based on that limitation. See *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991) (claiming a chimeric gene capable of being expressed in any cyanobacterium and thus defining the claimed gene by its use). In contrast, when a compound or composition claim is not limited by a recited use, any enabled use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for nonenablement based on how to use. If multiple uses for claimed compounds or compositions are disclosed in the application, then an enablement rejection must include an explanation, sufficiently supported by the evidence, why the specification fails to enable each disclosed use. In other words, if any use is enabled when multiple uses are disclosed, the application is enabling for the claimed invention.

The applicant has not provided a connotation of how to use the results in the specification or that the art recognizes that the standard mode of the results of applicant's invention are known and contemplated.

The Examiner has renewed the rejection under 35 USC 112, first paragraph. The specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

14. Claims 1-70 and 119-123 are rejected under 35 USC Section 101

Applicant states that the invention provides a ranked listing that is an aggregation of the judgment of the user. The applicant states that the evaluative judgments themselves are outside the scope of the invention.

The applicant states that the credible asserted utility of the invention is the aggregation of the user's judgments into a ranked listing of trade secrets. The applicant further states that the numerical score value in itself is not an output of the invention and

no credible asserted utility for it is required by statute. The utility of the ranked listing of the user's evaluative judgments need only be of value to the user himself and not to some third party hypothesized by the Examiner.

Thus, the Examiner asserts that the applicant has identified that the invention as claimed is not supported by either a specific and substantial asserted utility or a well established utility if the value need only be of value to the user himself.

15. Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 121 are rejected under 35 U.S.C. 102(e) as being anticipated by Donner (US 6, 263, 314).

The applicant primary argument is that the Examiner is ignoring the claim limitations requiring that the questionnaire be directed to the six factors of a trade secret. The applicant's claims are directed to systems. The questionnaire is data displayed on a screen.

Since applicant's invention is directed to a system, the Examiner looks at the structure defined in the claim language and whether the prior art has the capability of performing the steps that the applicant claims that applicant's structure can perform. While features of an apparatus or system may be recited either structurally or functionally, claims directed to an apparatus or system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional limitation can be performed by the prior art structure, the examiner should establish a *prima facie* case, and then the burden shifts to the applicant to prove otherwise. Applicant has failed to meet this burden. It is the

Examiner's position that Donner disclose all the claimed structural limitations and that the disclosed structure is capable of performing the recited function.

Since applicant is claiming a system in this application, applicant must identify in the specification the corresponding structure or the equivalents for the "means for." It is the Examiner's position that the applicant has failed to make clear the corresponding structure or acts disclosed in the specification for the means plus function language.

16. Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 121 are rejected under 35 U.S.C. 102(e) as being anticipated by Elder (US 6,393, 406).

The applicant's arguments are the same as addressed above in Number 15. Since applicant's invention is directed to a system, the Examiner looks at the structure defined in the claim language and whether the prior art has the capability of performing the steps that the applicant claims that applicant's structure can perform. While features of an apparatus or system may be recited either structurally or functionally, claims directed to an apparatus or system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional limitation can be performed by the prior art structure, the examiner should establish a *prima facie* case, and then the burden shifts to the applicant to prove otherwise.

17. Claims 42, 45-46, 58-59 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner and Elder as applied to claim 1 above, and further in view of Haber et al (US 5,136,646) (hereinafter referred to as Haber).

The applicant's arguments are the same as addressed above ( see 15). Since applicant's invention is directed to a system, the Examiner looks at the structure defined in the claim language and whether the prior art has the capability of performing the steps that the applicant claims that applicant's structure can perform. While features of an apparatus or system may be recited either structurally or functionally, claims directed to an apparatus or system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional limitation can be performed by the prior art structure, the examiner should establish a *prima facie* case, and then the burden shifts to the applicant to prove otherwise.

18. Claims 2 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner as applied to claim 1 above, and further in view of Eder.

The applicant's arguments are the same as addressed above (see 15). Since applicant's invention is directed to a system, the Examiner looks at the structure defined in the claim language and whether the prior art has the capability of performing the steps that the applicant claims that applicant's structure can perform. While features of an apparatus or system may be recited either structurally or functionally, claims directed to an apparatus or system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional

limitation can be performed by the prior art structure, the examiner should establish a *prima facie* case, and then the burden shifts to the applicant to prove otherwise.

19. Claims 119-120 and 122-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer (US 6,356,909) (hereinafter referred to as Spencer) in view of Barney et al (6,556,992) (hereinafter referred to as Barney).

Spencer discloses a questionnaire but does not disclose that the subject matter of the questionnaire is trade secrets or that the questions relate to the six factors for a trade secret of the First Restatement of Torts, or calculating a geometric mean, the sixth root of the product, of the numerical score values to create a single metric, or repeating the program for each of the remaining items to be evaluated or ranking the items in ascending or descending order of the calculated metric.

However Spencer in combination with Barney discloses repeating the program for each of the remaining items to be evaluated and ranking the items, wherein the items are patents and other intangible intellectual property assets (*trade secrets*).

Although Barney discloses a rating for patents and other intangible intellectual property assets, neither Spencer or Barney explicitly disclose rating trade secrets or the questions relating to the six factors for a trade secret of the First Restatement of Torts or calculating a geometric mean, the sixth root of the product, of the numerical score value.

However, a geometric mean is old and well known. Geometric mean as defined by the Merriam Webster on line dictionary as:

Main Entry: **geometric mean**  
Function: *noun*  
: the nth root of the product of  $n$  numbers; *specifically* : a number that is the second term of three consecutive terms of a geometric progression <the *geometric mean* of 9 and 4 is 6>

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Thus, the Examiner stated that It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Spencer to include a geometric mean that is the sixth root of the product since the applicant has identified six factors for a trade secret, thus the 6<sup>th</sup> root of the product of 6 numbers to come up with a numerical score value which can be used for comparison purposes when making an analysis of the trade secret.

The fact that the subject matter is about trade secrets or that the questions relate to the First Restatement of Torts is determined to be non-functional descriptive data. The language is not functionally interrelated with the useful acts, structure or properties of the claimed invention. The weighted scoring and ranking would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F. 3d. 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)

NOTE: Applicant has submitted several articles with this response. However, applicant has not related the articles to the rejection or arguments or provided a reason for the articles being submitted. Therefore, the Examiner has not considered the articles.

***Conclusion***

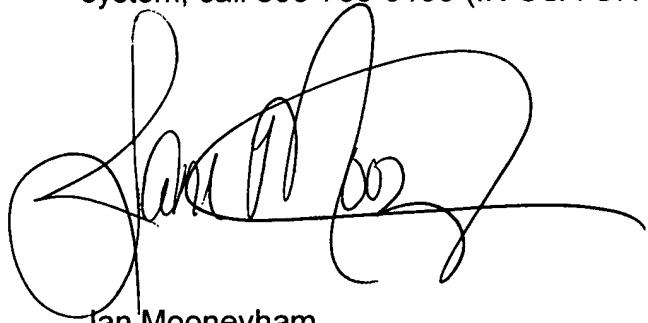
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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